

Office Action Summary

Application No.
08/887,680

Applicant(s)
Powell t al.

Examiner
David Y. Eng

Group Art Unit
2783



☒ Responsive to communication(s) filed on Jul 17, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-38 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 1-16 is/are allowed.

☒ Claim(s) 17-38 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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Claims 17-38 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Details of the rejection have already been set forth in the last Office action. The details are incorporated herein by reference thereto.

Applicants contend in the communication filed on April 10, 2000 that claims 1-38 contain the limitation of most and least significant bits only and therefore can not be interpreted as that the bit being tested can be set at any bit position. As set forth in the last Office action, the finally rejected and cancelled claims 55-72 of parent application do not specify which bit of the stack pointer register is tested and do not have the width setting step. Claims 55-72 therefore can be interpreted that the bit can be set at any position including the least and the most significant bits. Applicants argued for patentability of parent that the bit can only be set at the most significant

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position and that the width setting step is required. To support their argument, applicant cancelled claims 55-72 in order for claims 73-88 (remaining active claims of parent) to be allowed. The limitation of "least significant bit" recited in the reissue claims is within the scope of cancelled claims 55-72. This therefore amounts to recapture of cancelled claims 55-72.

Applicants further contend that reciting least significant bit is narrowing and not broadening the scope. The examiner disagrees. Given that setting the most significant bit is narrowest and setting any bit is broadest, adding another settable bit is broadening the claims.

Claims 17-38 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Details of the rejection have already been set forth in the last Office action. The details are incorporated herein by reference thereto.

Applicants' arguments presented on April 4, 2000 are based on hindsight and speculation. The fact is that setting at the least significant bit is not disclosed and that applicants rely on the limitation that it can only be set at the most significant bit for patentability.

Claims 33-38 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.

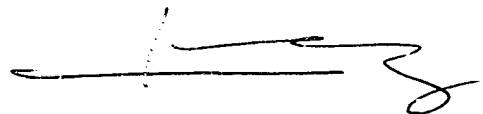
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Details of the rejection have already been set forth in the last Office action. The details are incorporated herein by reference thereto.

No arguments directed to this rejection are presented in the April 10, 2000 communication.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.



**DAVID Y. ENG
PRIMARY EXAMINER**